

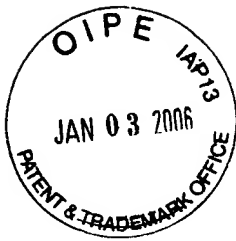
AF
JW

PTO/SB/21 (09-04)
Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Project of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/899,066-Conf. #003176	
	Filing Date	July 6, 2001	
	First Named Inventor	Se PARK	
	Art Unit	2615	
	Examiner Name	B. J. Jelinek	
Total Number of Pages in This Submission	12	Attorney Docket Number	0630-1287P

ENCLOSURES (Check all that apply)				
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):		
<table border="1"><tr><td>Remarks</td></tr><tr><td>Reply Brief</td></tr></table>			Remarks	Reply Brief
Remarks				
Reply Brief				

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm Name	BIRCH, STEWART, KOLASCH & BIRCH, LLP		
Signature			
Printed name	Scott L. Lowe		
Date	January 3, 2006	Reg. No.	41,458



MS APPEAL BRIEF - PATENTS

Docket No.: 0630-1287P

(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Se Woong PARK

Application No.: 09/899,066

Confirmation No.: 003176

Filed: July 6, 2001

Art Unit: 2615

For: CONTROL METHOD OF CCD CAMERA

Examiner: B. J. Jelinek

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

January 3, 2006

Sir:

Appellant hereby replies to the newly presented Examiner's responses in the Examiner's Answer to Appellant's arguments in the Appeal Brief filed on August 23, 2005.

I. On page 22 of the Examiner's Answer, the Examiner correctly points out that Chino's disclosed digital VCR is a digital video camera recorder.

II. Page 3 of the Examiner's Answer cites U.S. Patent 6,262,768 to Williams for the first time and indicates that the Williams patent is evidence relied on by the Examiner. On page 24 of the Examiner's Answer, the Examiner states that Williams is provided as evidence under MPEP §2144.03(d) that it was well known in the art at the time of the invention to provide a zoom lens for day/night color and black and white CCD surveillance cameras, referencing col. 3, lines 27-42 and col. 4, lines 24-26.

Appellant respectfully submits that the final rejection of claims 1-5, 9, 11-13, 17 and 26-27 does not rely on Williams and that the Examiner's Answer does not modify the final rejection in any way based on Williams. Instead, it just makes the aforementioned statement without relating Williams to either of the applied references or to the specific rejection under 35 U.S.C. §103(a) of claims 1-5, 9, 11-13, 17 and 26-27 based on Beis and Chino. As such, the relevance of Williams to proper motivation to combine Beis and Chino as suggested has not been presented and Appellant is left to guess at what that relevance is.

Nevertheless, if the issue with respect to which Williams is relied on is the combinability of the prior art, Appellant respectfully submits that, when an

obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the "absence of such a suggestion to combine is dispositive in an obviousness determination"). Whether motivation to combine the references was shown we hold a question of fact. See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("[P]articular *factual* findings regarding the suggestion, teaching, or motivation to combine serve a number of important purposes . . .") (emphasis added); Monarch Knitting, 139 F.3d at 881-83, 886, 45 USPQ2d at 1982, 1985 (treating motivation to combine issue as part of the scope and content of the prior art and holding that genuine issues of *fact* existed as to whether one of ordinary skill in the art would have been motivated to combine the references in question).

In this regard, the Examiner's Answer presents absolutely no reason to, nor any objective factual evidence of a reason to, use Williams to provide proper motivation for one of ordinary skill in the art to modify Beis in view of Chino.

In fact, Williams differs substantially from both Beis and Chino. Whereas Beis has a single camera with black and white and color sensing units, and uses a single fixed focus lens system, and Chino has a single camera with black and white and color sensing units using a single lens system, Williams

has two separate cameras, each having its own different lens system. As stated in the Abstract of Williams, “[A]n adjustable zoom lens is coupled to each of its cameras.” Nor does Williams switch a filter into and out of a single lens path to achieve day/night operation.

Nor does Williams operate as suggested on page 24 of the Examiner’s Answer. As noted above, the Examiner’s Answer refers to Williams as evidence that it was well known “to provide a zoom lens for day/night color and black and white CCD surveillance cameras (emphasis added).” This statement is not correct because Williams actually discloses using two separate zoom lenses for two separate cameras.”

Moreover, Appellant respectfully submits that Williams’ disclosure is nothing more than a broad general statement about two separate cameras with zoom lenses, the relevance of which to properly motivating one of ordinary skill in the art to modify Beis in view of Chino, which differ significantly from Williams has not been presented, nor is it clear from the Examiner’s Answer.

III. On page 24 of the Examiner’s Answer, the Examiner provides no objective factual evidence in support of the speculative conclusion that providing a zoom lens for lens 3 of Fig. 1 of Beis does not alter the operation or relationship between the lens system and the image sensors 4 and 11 of Beis. This response does not take into consideration the disclosure of Chino, in col. 4, lines 45-61, which clearly points out that an out-of-focus situation occurs

for a zoom lens due to the insertion and removal of the ND filter and reflects an improper presumption on which the rejection of claims 1-5, 9, 11-13, 17 and 26-27 is based.

IV. On pages 24-25 of the Examiner's Answer, the Examiner states that the teaching of Chino was used to illustrate that upon inserting optical filters into the path length, it is necessary to use a second zoom tracking curve to compensate the change in optical path length of a zoom lens optical system.

In response, Appellant respectfully submits that one of ordinary skill in the art would not look to Chino to modify Beis just because they both use filters insertable in the optical path of a camera, because thousands of cameras do that and that feature does not provide motivation to modify the fixed focus device of Beis with the zoom lens device of Chino. Moreover, one of ordinary skill in the art is faced with the simple fixed focus system of Beis, on the one hand, and a far more complex variable focus zoom lens system of Chino, and is faced with trade-offs between these significantly different systems including the simplicity of Beis and the complexity of Chino. Appellant respectfully submits that trade-offs such as this concern only what is feasible, not what is, on balance, desirable, and motivation to combine such disparate references requires what is desirable, not just what is feasible. The fact that something may be modified is completely different from whether a skilled worker is motivated to make a proposed modification of that something.

V. On page 26 of the Examiner's Answer, the Examiner relies on, for evidence of proper motivation to modify Beis in view of Chino, the broad, general statement that Beis and Chino are from the same general field of endeavor and are reasonably pertinent to the particular problem with which the Appellant was concerned. Appellant respectfully submits that thousands of references are from the field of imaging devices and that these two references are not directed to the particular problem with which Appellant is concerned. Appellant is concerned with a camera and a control method of a camera that detects the illumination of a region to be photographed, compares the detected illumination with a reference illumination value, setting a photographing mode on the basis of the comparison and controls movement of a camera lens using pre-stored trace data of the lens. Beis, the main reference upon which the rejection of the pending claims is based, has no disclosure of a camera with lens movement, or of a camera that has anything to do with focusing a zoom lens or zooming a zoom lens. Chino is concerned with a zoom lens control system for a generic digital VCR designed to change the magnification of a picture by moving a zoom lens while maintaining an in-focused state (col. 1, lines 13-20) when a filter is inserted in or removed from the zoom lens. Chino has no disclosure of detecting the illumination of a region to be photographed and comparing the detected illumination with a reference illumination value and setting a photographing mode on the basis of the comparison.

Thus, these references are seen to not only differ substantially from one another, but also each one differs substantially from addressing the particular problem with which Appellant is concerned.

VI. On page 27 of the Examiner's Answer, the Examiner refers to Williams, which has not been made part of the final rejection and is only cited to teach the combination of a security camera and a zoom lens. Appellant is not claiming the combination of a security camera and a zoom lens and, as pointed out above, Williams actually discloses two separate cameras with two separate zoom lenses, which is significantly different than what is claimed or what is disclosed in either Beis or Chino. Actually, Williams is discussed not in terms of the rejection but only in terms of rebutting one of Appellant's arguments alleging improper motivation to combine Beis and Chino without any reasoning being presented concerning why Williams provides proper motivation to modify the two significantly different Beis and Chino references.

VII. On page 28 of the Examiner's Answer, the Examiner clearly highlights the fact that Beis and Chino are fundamentally different and that neither of these references discloses or suggests the relationship of using first trace data to a daylight mode or of suggesting the relationship of a second trace data to a nighttime mode or of controlling the movement of a lens on the basis of the first and second trace data. By stating that Beis merely discloses

inserting a filter into the optical path to switch to a daytime mode, the Examiner admits that Beis fails to disclose or suggest the relationship of using first trace data to a daylight mode or of suggesting the relationship of a second trace data to a nighttime mode or of controlling the movement of a lens on the basis of the first and second trace data. Also, by stating that Chino teaches using a second zoom tracking curve to compensate for a change in optical path length, the Examiner admits that Chino does not disclose switching from a nighttime mode to a daytime mode by inserting a filter into a camera's optical path and does disclose controlling the movement of a lens on the basis of the first and second trace data.

VIII. On page 28 of the Examiner's Answer, with respect to the rejection of claims 6-8, 10, 14-16 and 18-25, the Examiner states that Mizoguchi teaches the motivation to provide an OLPF filter during photographing with a color image sensor in the daytime for preventing aliasing in color images that contain high special frequencies. Appellant respectfully disagrees. In fact, in col. 1, lines 40-55, Mizoguchi actually teaches that, when photographing in black and white, one may either remove a low pass filter or use a low pass filter depending on the spatial transmission frequency spectrum of the low pass filter. Moreover, Mizoguchi is concerned with photographing documents (col. 1, lines 35-55) and uses different crystal low pass filters depending on the resolution employed – see col. 3, lines 5-40, for example, whereas Beis is

concerned with surveillance using a fixed focus lens 1, and Chino is interested in maintaining autofocus in a zoom lens system when the system becomes out of focus due to insertion or removal of a neutral density filter in the path of the zoom lens. Thus, it is clear that Mizoguchi, which is directed to imaging different objects with different characteristics than either Beis or Chino, does not provide proper motivation for modifying the improper Beis-Chino reference combination at all.

IX. On page 29 of the Examiner's Answer, the Examiner focuses on different aspects of each of the applied references, a fact that Appellant believes indicates the fundamental differences between these references, differences that teach away from combining these references, as suggested, for the reasons stated in Appellant's main Appeal Brief, and in the preceding paragraph. In fact, these differences support the conclusion that the only reason for combining these three disparate references is improper hindsight combination of those disparate references based solely on Appellant's disclosure.

X. On page 30 of the Examiner's Answer, the Examiner states that Mizoguchi teaches the motivation to provide an OLPF filter during photographing with a color image sensor in the daytime mode to prevent aliasing in color images that contain high special frequencies and that aliasing is inherent in the image sensor. Appellant respectfully submits that Mizoguchi

is directed to preventing aliasing in certain specific instances, such as those found in copying documents that introduce aliasing due to, for example, moiré effects caused not by the image sensor itself, but by the imaging of specific objects that are being photographed, and specifically, printed documents. In other words, Mizoguchi is directed to reducing aliasing in the low resolution mode using a specific low-pass filter and in the high resolution photographing mode using a different low pass filter (col. 3, lines 16-40) by varying the iris control depending on which mode is selected. The Examiner fails to demonstrate what this has to do with Beis and Chino and why it would be obvious to modify Beis and Chino as suggested, especially when no objective factual evidence has been presented that either Beis or Chino face the problem faced by Mizoguchi.

XI. On page 31 of the Examiner's Answer, the Examiner discusses claim 21, which recites a combination of features including (1) converting a photographing mode of the CCD camera into the daytime mode or the nighttime mode by judging whether the detected illumination is not less or greater than a reference illumination value; (2) loading the first trace data for controlling a lens of the CCD camera so as to photograph the photographing region through an OLPF (Optical Low Pass Filter) when the photographing mode is converted into the daytime mode; (3) loading the second trace data for controlling the lens of the CCD camera so as to photograph the photographing

region without imaged light of the photographing region passing through the OLPF when the photographing mode is converted into the nighttime mode; and (4) adjusting a focus of the lens of the CCD camera on the basis of the loaded trace data.

The Examiner explains that each reference discloses a different feature and simply concludes that it would be obvious to combine the three applied references with no objective factual evidence presented to provide proper motivation to combine these three disparate references. However, as noted in Appellant's main Brief, this speculative statement fails to provide objective factual evidence of proper motivation to modify Beis in view of Chino and/or Mizoguchi, as suggested.

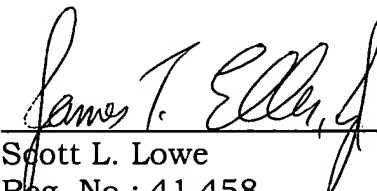
Appellant respectfully submits that a fair, balanced appraisal of the applied art reveals that there is no motivation to combine these references, as suggested, (1) for the reasons presented in the main brief, and (2) for reasons discussed above, including that because there is no apparent disadvantage to or problem with Beis, the base reference, and therefore, the motivation to combine Beis and Chino would not stem from the "nature of the problem" facing one of ordinary skill in the art, because no "problem" is perceived to exist in Beis; and because of the obvious trade-off between using a simple, fixed focus camera like that of Beis and the more complicated zoom lens camera of Chino that is not even disclosed as being used for surveillance purposes where

trade-offs concern what is feasible, not what is, on balance, desirable, which is required for motivation.

Accordingly, Appellant respectfully submits that the final Office Action fails to make out a *prima facie* case of obviousness of the invention recited in claims 1-28, and respectfully requests that the final rejection of independent claims 21 and 28 and of dependent 6-8, 10, 14-16, 18-20 and 22-25 is improper and should be reversed.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By:  #39,538
Scott L. Lowe
Reg. No.: 41,458

SLL/RJW:gf 

P.O. Box 747
Falls Church, Virginia 22040-0747
Telephone: (703) 205-8000